

Appl. No. 10/706,103
Docket No. 9118M2
Amdt. dated May 26, 2009
Reply to Office Action mailed on February 27, 2009
Customer No. 27752

REMARKS

Claim Status

Claims 1-4 and 8-17 are pending in the present application. Claims 5-7 have been previously canceled without prejudice.

Rejection Under 35 USC §103(a) Over Lawlor in view of Fine, et al.

The Office Action rejects claims 1-4, 8-12 and 14 under 35 USC §103(a) as being unpatentable over Lawlor (US 6,706,256) in view of Fine, et al. (US 4,374,822). Claims 13 and 15-17 are rejected under 35 USC § 103(a) as being unpatentable over Lawlor in view of Fine as evident by Grossman et al. J. Dent. Res. 16(5), 409-416, 1937. Applicants traverse and respectfully argue that the cited references do not establish a *prima facie* case of obviousness.

Lawlor, as has been discussed in previous responses, does not disclose any of the claimed retentive agents *at the levels used* in the present invention. As demonstrated in the declaration and data previously submitted and entered into the record (June 12, 2007 response to December 12, 2006 Office Action), the composition of the present invention, when chewed, is deposited and retained in the subject's teeth for at least 5 minutes and up to 60 minutes.

The latest Office Action notes and relies on the fact that Lawlor discloses some of the same water-insoluble particulate retentive agents as the present invention. But Applicants contend that it is inaccurate to assume that the mere presence of the claimed materials in Lawlor makes obvious their use at particular levels not disclosed. The amount of these water-insoluble materials present in a composition has a critical effect on the character and properties of the composition. The present invention does not claim merely a composition with certain water-insoluble retentive agents in the formula, but certain water-insoluble retentive agents at *particular levels*. The Office Action, to support its inaccurate assumption, emphasizes Lawlor's disclosure that its compositions may have a noticeable crunchy sensation. But, to begin, the "crunchy sensation" to which Lawlor refers (col. 17) comes from the oral care actives listed previously or from "a

further particle such as sugar crystals, dried fruits, nuts, etc.”, not the “teeth colour modifying substances” listed later (col. 19). And, more importantly, Lawlor emphasizes that the crunchy texture should disappear by 5 minutes, preferably by 4. To the extent that the “crunchy sensation” of Lawlor can be translated into remaining visible in a subject’s teeth (an analogy Applicants reject), Lawlor discloses a distinctly different result from the present invention. Lawlor discloses that its compositions will have “disappeared” after 5 minutes, while the present invention claims to remain visible for 5 to 60 minutes.

Applicants argue that the citing of the Fine reference does not close the loop and render the present invention obvious. While Fine discloses compositions containing broad ranges of water-insoluble polishing agents, it is clear that Fine’s focus is its flavoring, and that it never even contemplated nor desired a composition that would stick and remain visible in a subject’s teeth for an extended period of time. Therefore, Applicants respectfully argue that it would be not obvious, but quite random, to combine Fine and Lawlor to provide the present invention’s composition. There is a total lack of motivation, teaching, or suggestion to combine Fine’s dental creams with Lawlor, especially noting that there is no mention in either reference of a result or a desire to have the composition stick and remain visible in a subject’s teeth. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability ... the essence of hindsight.”¹

Applicants understand that a determination of obviousness involves judgment and that there are times where both sides of an argument can be persuasive. But, in this instance, the Applicants argue that the determination is clear and that there is no *prima facie* case of obviousness. Applicants respectfully request that the rejection be withdrawn.

¹ *In re Dembiczak* 175 F. 3d 994, 999 (Fed. Cir. 1999), citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 U.S.P.Q. (BNA) 543, 547 (Fed. Cir. 1985).

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Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By /Kathleen Y. Carter/
Kathleen Y. Carter
Registration No. 60,583
(513) 983-2114

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